

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 10

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte GREGORY M. SERDUKE

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Appeal No. 1998-1969  
Application No. 08/535,708<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge,  
FRANKFORT and NASE, Administrative Patent Judges.

NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 13 through 17. Claims 1, 3 through 7 and 10 through 12 have been allowed. Claims 2, 8 and 9 have been canceled. Subsequent to the appeal, claim 17 has been

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<sup>1</sup> Application for patent filed September 28, 1995.

objected to as depending from a non allowed claim (answer, p. 4). Thus, claims 13 through 16 remain on appeal.<sup>2</sup>

We AFFIRM.

#### BACKGROUND

The appellant's invention relates to a dispensing device (claims 15 and 16) and a method of dispensing items (claims 13 and 14). An understanding of the invention can be derived from a reading of exemplary claims 13 and 15, which appear in the appendix to the appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Hotaling 1918	1,285,187	Nov. 19,
Crawford et al. 1994 (Crawford)	5,363,987	Nov. 15,

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<sup>2</sup> The appellant's amendment after final (Paper No. 5, filed July 14, 1997) was not entered by the examiner (see paper No. 6, mailed July 25, 1997).

Claims 13 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hotaling in view of Crawford.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 9, mailed December 16, 1997) for the examiner's complete reasoning in support of the rejection, and to the appellant's brief (Paper No. 8, filed October 20, 1997) for the appellant's arguments thereagainst.

#### OPINION

Initially we note that the appellant's request that the Board enter his Rule 116 amendment relates to a petitionable matter and not to an appealable matter. See Manual of Patent Examining Procedure (MPEP) §§ 1002 and 1201. Accordingly, we will not review this issue raised by the appellant on pages 10-11 of the brief.

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and

claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

Hotaling discloses a newspaper vending machine. As shown in Figure 1, the newspaper vending machine includes a cabinet A, a dispensing opening 1, a shelf 2, a swinging arm B having a dispensing tooth 15, and a handle 20 which projects out of a slot 21 in the coin-controlled mechanism chamber 22. The shelf 2 supports a pile of newspapers with each paper lying on its edge so that its face will be in a vertical plane. Hotaling teaches (page 2, lines 35-38) that "the handle 20 is again operated after a coin has been deposited" in the coin-controlled mechanism chamber 22, which mechanism is not disclosed by Hotaling since it forms no part of his invention (see page 2, lines 15-18).

Crawford discloses a newspaper vending unit. As shown in the drawings, the newspaper vending unit includes an outer cabinet 12 (Figures 1 and 8), a publication storage mechanism

14 (Figures 2, 3, 6 and 7), and an actuator mechanism 16 (Figures 2, 4 and 9). As shown in Figure 1, the outer cabinet 12 includes a front panel assembly 18 having a chute 34, a publication receiving tray 36, coin slot 230, knob 190 of the actuator mechanism 16, and a window 38 through which the publication may be viewed prior to sale.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on the examiner's analysis and review of Hotaling, the examiner determined (answer, p. 5) that Hotaling lacks only the window as recited in claims 13 through 16. We agree. In fact, the appellant has not disputed this finding of the examiner.

In applying the test for obviousness,<sup>3</sup> we reach the conclusion that it would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the front panel of Hotaling's newspaper vending machine (i.e., the panel shown in Figure 1 of Hotaling) with a window through which the newspaper may be viewed prior to sale as suggested and taught by Crawford's window 38 thereby arriving at the method of dispensing items as recited in claims 13 and 14 and the dispensing device as recited in claims 15 and 16.

The arguments advanced by the appellant in the brief are unpersuasive for the following reasons.

The appellant argues (brief, pp. 7-9) that Crawford does not teach or suggest a window having the purpose of the present window (i.e., to permit the customer to view the inner

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<sup>3</sup> The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

workings of the machine while the customer uses an outer arm to control an inner arm to grasp an item in the magazine and move it to a dispensing chute as set forth in claims 13 to 15). This argument is not persuasive that any error in the determination regarding the obviousness of the claimed subject matter has occurred. As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991) and In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992).

The appellant next argues (brief, pp. 7-8) that it is not apparent how one would install a window from Crawford into the device of Hotaling. In addition, the appellant states that "it would be logical to put the window of Crawford on the side of the enclosure opposite the dispensing handle." We do not agree. Crawford clearly teaches providing the window to view the publication at the front side of the vending unit (i.e.,

the side in which the customer places the coins, actuates the dispensing mechanism, and receives the dispensed publication). From this teaching of Crawford it is our view that one of ordinary skill in the art at the time the invention was made would have provided the front panel of Hotaling's newspaper vending machine (i.e., the panel shown in Figure 1 of Hotaling having the coin-controlled mechanism chamber 22, the handle 20, and the dispensing opening 1) with a window through which the newspaper may be viewed prior to sale. In addition, we note that the appellant has not provided any evidence that would support his allegation that it is not apparent how one would install a window from Crawford into the device of Hotaling. Moreover, it is our opinion that in view of Crawford's teachings one of ordinary skill in the art would have made the front panel of Hotaling transparent to permit the newspaper to be viewed prior to sale as suggested and taught by Crawford's window 38.

For the reasons stated above, the decision of the examiner to reject claims 13 through 16 under 35 U.S.C. § 103 is affirmed.



CONCLUSION

To summarize, the decision of the examiner to reject claims 13 through 16 under 35 U.S.C. § 103 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
CHARLES E. FRANKFORT	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

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Page 10

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APPEAL NO. 1998-1969 - JUDGE NASE  
APPLICATION NO. 08/535,708

APJ NASE

APJ FRANKFORT

SAPJ McCANDLISH

DECISION: **AFFIRMED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 20 Apr 99

**FINAL TYPED:**